

Applicant requests Examiner to reconsider the rejection of claims 1 through 9 under 35 U.S.C. § 101 as failing to be directed to statutory subject matter. Applicant submits that claims 1 through 9 are directed to embodiments of a new and useful process that is statutory subject matter under 35 U.S.C. § 101.

A. Anything under the sun that is made by man.

In Diamond v. Chakrabarty, 447 U.S. 303, 309; 206 USPQ 193, 197 (1980), the Supreme Court held that Congress, through legislative history, intended statutory subject matter to ***“include anything under the sun that is made by man.”***

While an abstract idea *per se* is not patentable subject matter under 35 U.S.C. § 101, when an abstract idea is reduced to a practical application that produces a **useful, concrete and tangible result** the requirements of 35 U.S.C. 101 are satisfied. In re Alappat, 31 USPQ 2d 1545, 1558 (Fed. Cir. 1994); State Street Bank & Trust Co. v. Signature Financial Group. Inc., 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998).

Specifically, if a useful, concrete and tangible result occurs, a process, machine, manufacture, or composition of matter employing a law of nature, natural phenomenon, or abstract idea may be patentable subject matter even though the law of nature, natural phenomenon, or abstract idea would not, by itself, be patentable subject matter. State Street Bank & Trust Co. v. Signature Financial Group. Inc., *supra*.

Moreover, a method or process remains statutory subject matter even if some or all of the steps therein can be carried out in the human mind, with the aid of the human mind, or because it may require one performing the method or process to think. In re Musgrave, 431 F.2d 882, 893; 167 USPQ 280, 289 (CCPA 1970.)

Significantly, the Courts have not held that a process must be within the "technological arts." Since claims 1 through 9 each produce a useful, concrete and tangible result, the requirements of 35 U.S.C. § 101 are satisfied and the rejections under 35 U.S.C. § 101 should be withdrawn.

B. Biological technology

Alternatively, claims 1 through 9 are directed to a biological technology and thereby satisfy the Examiner's "technological arts" requirement. Specifically, the invention includes categorizing pets, which are living biological animals. The biological factors that are the subject matter of the invention include the breed, weight and exercise requirement of dogs. As described in the seventh and eighth full paragraphs following the "DESCRIPTION OF THE PREFERRED EMBODIMENT" heading, the breeds are identified by experts. The American Kennel Club recognizes breeds based on shared biological characteristics. Further, the weight of each breed is the ideal weight of an adult dog of the breed as published by the American Kennel Club. The exercise requirement is based on information obtained from published sources; namely the Encyclopedia of Dogs, by D. Caroline Coile, Ph.D., published by Barrons, ISBN 0-7641-5097-0, and is based on the activity expected from typical dogs of each breed.

As biology is an established science and technology, the processes of claims 1 through 9, which are directed to a biological technology, are within the technological arts. Accordingly, Applicant submits that the requirements of 35 U.S.C. § 101 are satisfied and the rejections under 35 U.S.C. § 101 should be withdrawn.

**III. Claim Rejections – 35 U.S.C. § 102**

Applicant requests Examiner to reconsider the rejection of claims 1 through 13 under 35 U.S.C. section 102(e) as being anticipated by Bebiak et al. ("Bebiak.")

Applicant's claims 1 through 7 claim a method of matching a pet with an appropriate product, and claims 10 through 13 claim an apparatus to match a pet with an appropriate product. Bebiak teaches making a customized pet food in response to information relating to the pet. Accordingly, claims 1 through 7 and 10 through 13 are not anticipated by Bebiak.

Applicant's claims 8 and 9 claim a product for a pet or container therefor having thereon indicia indicating that the product is compatible with a pet having the same or corresponding indicia. Bebiak does not teach the use of indicia indicating that the product is compatible with a pet having the same or corresponding indicia. Rather Bebiak teaches the use of printed material containing "customized pet feeding and care information for the individual pet, along with an ingredient statement, guaranteed analysis of the pet food, and a product label ..... recommendations regarding the use of treats and supplements, exercise of the pet, and veterinary care ..... customer notices or reminders for food re-orders, pet birthday cards, veterinary visits, and special promotions" (C.3 l. 34 – 43). Accordingly, claims 8 and 9 are not anticipated by Bebiak.

Based on the foregoing, Bebiak clearly does not anticipate Applicant's claims 1 through 13.

### **CONCLUSION**

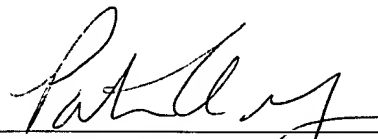
In view of the above, Applicant maintains that all points raised by the Examiner have been answered. The claims now presented are in condition for allowance.

Reconsideration and favorable action are earnestly solicited.

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Respectfully Submitted,

A handwritten signature in cursive script, appearing to read 'Patricia A. Wenger', written over a horizontal line.

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